

REMARKS

In the Office Action, claim 3 is rejected under 35 U.S.C. §112, second paragraph. Because formulas 2 and 3 are narrower versions of formula 1, the preamble of claim 3 has been amended for clarification purposes. No new matter is added thereby.

Next, the Office Action rejects claims 1, 3, 8 and 11-20 under 35 U.S.C. §102(b) as allegedly being anticipated by European Patent 1 164 434 ("Nishimura"). In response, Applicants present the following remarks.

At the outset, under MPEP § 2131,

[t]o anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Citing, Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Nishimura does not teach or suggest a polymer that comprises a repeating unit of Formula 1, a polymer which comprises a repeating unit of Formula 2 or a polymer which comprises a repeating unit of Formula 3 and therefore independent claim 1 or dependent claims 3, 8 and 11-20 cannot be anticipated by Nishimura.

Specifically, Nishimura discloses a radiation sensitive resin composition that includes an acid-labile group-containing resin. The acid-labile group-containing resin includes repeating units of Formulas I-1 and III-1 as set forth on page 51, example 22 of Nishimura. While the repeating unit of Formula I-1 is relevant to the polymer of claim 1, the repeating unit of Formula III-1 of Nishimura is not. Specifically, the repeating unit of Formula III-1 of Nishimura includes a methacrylate group unit in the main chain. See Formula III-1.

In contrast, the polymer of claim 1 includes a repeating unit including (1) a polycyclic monomer moiety and (2) a *single carbon moiety* having an ester group (see the units b, c or e of Formulas 1-3 of claims 1 and 3). Thus, the main chain of the polymer of

Formula 1 includes the polycyclic monomer moiety and the single carbon moiety. If the moiety c is present, then the main chain includes a polycyclic moiety and two single carbon ester moieties.

Thus, examples 17 and 22 of Nishimura are structurally different from claim 1 and therefore Nishimura cannot anticipate claim 1.

The Patent Office takes the position at page 11, lines 30-53 of Nishimura, teaches the equivalents of substituting a hydrogen for the methyl group in the alpha-position of the repeating unit III-1. However, page 11 only teaches that the R₆ group can be a hydrogen atom. Page 11 does not teach or suggest the removal of the additional carbon atom from the backbone which makes the teaches of Nishimura clearly different from Formulas 1-3 of claims 1 and 3 of the present application.

To be clear, Formulas 1-3 of claims 1 and 3 clearly recite single carbon moieties on the main chain for groups b, c and e. Nishimura, on the other hand, only teaches a two carbon moiety for the moiety in addition to the cyclic group and therefore the teachings of Nishimura are clearly different from claim 1 and claim 1 cannot be anticipated by Nishimura. Therefore, Applicants respectfully submit that the rejection of claims 1, 3, 8 and 11-20 under 35 U.S.C. §102(b) as being anticipated by Nishimura is improper and should be withdrawn.

Finally, the Office Action rejects claim 2 under 35 U.S.C. §103 as allegedly being obvious in view of Nishimura. However, under MPEP §§ 2142 and 2143,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Citing, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

Nishimura cannot serve as an obviating reference for claim 2 because of its failure to teach or suggest all of the claim limitations of claim 1, from which claim 2 depends. Specifically, Nishimura fails entirely to teach or suggest the polymer of Formula 1 for the reasons set forth above and therefore not all of the limitations of claim 1 are taught or suggested by Nishimura. Accordingly, Nishimura fails to establish a *prima facie* case of obviousness for claim 1 and therefore Applicants respectfully submit that the rejection of claim 2 under 35 U.S.C. §103 as being unpatentable over Nishimura is improper and should be withdrawn.

An early action indicating the allowability of claims 1-20 is respectfully requested.

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